

MARTIN SUGAR ET AL.
USSN 09/763,106

ADDITIONAL FEE

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REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why the amendments above are necessary and were not presented earlier. The amendments are necessary to overcome the new grounds of rejection contained in the final rejection. Since this is the first substantive response to the final rejection, these amendments could not have been presented earlier. In view of the foregoing, Applicants submit that a proper showing has been made, and, therefore, that the Examiner should enter and consider these amendments. An early notice that these amendments have been entered and considered is earnestly solicited.

Amendments have been made to claims 7 and 13. A clean copy of claims 7 and 13 is presented above. A mark-up showing the changes that have been made to claims 7 and 13 using brackets and underlining is attached.

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Claims 7-12 were rejected under 35 USC §112, first paragraph, as being broader than the enabling disclosure. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. Applicants would remind the Examiner that the allegations in the specification must be accepted as true in the absence of reasonable doubts supported by sound technical reasoning or evidence. *In re Marzocchi et al.*, 169 USPQ 367, 369 (CCPA 1971). The Examiner has not provided any sound technical reasoning or evidence tending to cast doubts on Applicants' assertion that the attachment of a lauryl ether sulfate to human skin can be prevented during a washing process. In the absence of such sound technical reasoning or evidence, this rejection is untenable and should be reconsidered and withdrawn.

The Examiner says that Applicants have not provided any data showing prevention of the attachment of a lauryl ether sulfate to human skin. However, the initial burden is on the Examiner to make out a *prima facie* case of lack of enablement. Only when the Examiner's burden is satisfied does the burden shift to Applicants to come forth with data proving operability. Since the Examiner has not made out a *prima facie* case of lack of enablement for the reasons given above, Applicants submit that they were under no obligation to provide any data showing prevention of the attachment of a lauryl ether sulfate to human skin.

The Examiner also says that the skin cleanser/detergent art is unpredictable, and that it would require undue experimentation for one skilled in the art to determine prevention of attachment of a lauryl ether sulfate to human skin. In response, Applicants point out that there is absolutely no support whatsoever for the Examiner's position on the present record. Prevention

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of the attachment of a lauryl ether sulfate to human skin is not, on it's face, an inherently incredible or speculative endeavor. The Examiner apparently accepts that the attachment of a lauryl ether sulfate to human skin can be reduced (claim 7) or that an adsorbed lauryl ether sulfate can be desorbed from human skin (claim 13). Obviously, therefor, the Examiner accepts that the instant detergents can interfere with the attachment of a lauryl ether sulfate to human skin. Respectfully, it is not seen why the Examiner doubts that the interference can be to the extent of prevention.

Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 12 and 18 were rejected under 35 USC §112, second paragraph, as being indefinite. In response, Applicants point out that claim 7 has been amended to recite the presence in the preparation of a lauryl ether sulfate, thereby providing antecedent basis for claim 12. With respect to claim 18, Applicants point out that this claim has been canceled, and, therefore, antecedent basis for the lauryl ether sulfate is not required in claim 13.

For the record, Applicants emphasize that although the claims were amended to overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did

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not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

Claims 7-11 and 13-17 were rejected under 35 USC §102(b) as being anticipated by or, in the alternative, under 35 USC §103(a) as being obvious over EP 0 648 833. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants submit that EP 0 648 833 does not teach every limitation of any of the rejected claims, and, therefore, there is no anticipation. Further, the untaught limitations are not taught or suggested by EP 0 648 833, and, therefore, there is no obviousness either.

With respect to claims 7-11, Applicants point out that claims 8-11 have been canceled, and claim 7 has been amended to require that the preparation contain a content of a lauryl ether sulfate. The Examiner concedes that EP 0 648 833 does not teach a lauryl ether sulfate. Consequently, this reference cannot alone anticipate or render obvious claim 7.

With respect to claims 13-17, Applicants point out that these claims require that the preparation be applied to human skin comprising an adsorbed lauryl ether sulfate. Since EP 0 648 833 does not teach a lauryl ether sulfate, this reference cannot possibly anticipate or render obvious the application of the instant preparation to such human skin. Further, since previous

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claim 13 was drawn to a method of desorbing a lauryl ether sulfate from human skin, necessarily the human skin comprised an adsorbed lauryl ether sulfate, otherwise it would not be possible to desorb the lauryl ether sulfate therefrom. In short, the amendment to claim 13 to specify the human skin was implicit in the previous wording of claim 13 and did not introduce new matter. Accordingly, both previous claims 13-17 and current claims 13-17 are not anticipated or rendered obvious by EP 0 648 833 alone.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1-18 were rejected under 35 USC §103(a) as being obvious over EP 0 648 833 in combination with DE 43 04 066. In response, Applicants submit that either no *prima facie* case of obviousness is made out in the first place or else the rejected claims are characterized by unexpected results. In either case, the Examiner should reconsider and withdraw this rejection.

According to the Examiner, it would have been obvious to add sodium lauryl ether sulfate as taught by DE 43 04 066 to the compositions of EP 0 648 833 for its art-recognized surfactant properties. However, as discussed in the instant specification on pages 1 and 2, sodium lauryl ether sulfate has well-known irritant properties (see especially the last paragraph on page 1 of the specification.) These irritant properties are so notorious that persons skilled in

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the art have often replaced a content of sodium lauryl ether sulfate by milder surfactants in order to decrease the skin irritability (see the fourth paragraph on page 2 of the specification.)

Even if the Examiner is correct that a person skilled in the art would have had motivation to add sodium lauryl ether sulfate to the compositions of EP 0 648 833, the only expectation that such person could have had would have been that the resultant modified compositions would be skin irritating. There is absolutely nothing in the cited combination of references that would have suggested to such persons that the irritant potential of sodium lauryl ether sulfate could be eliminated or significantly reduced, in other words, that the deleterious attachment of the sodium lauryl ether sulfate to the skin could be prevented or reduced (claims 7 and 12) or that any sodium lauryl ether sulfate adsorbed to the skin could be desorbed (claims 13-17). Such a result is of significant practical importance and is not taught or suggested by the cited combination of references. The present invention, thus, allows for the first time the use of higher concentrations of sodium lauryl ether sulfate without the fear of skin irritation. Consequently, the cited combination of references does not establish that the claimed methods would have been *prima facie* obvious to persons skilled in the art.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

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Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

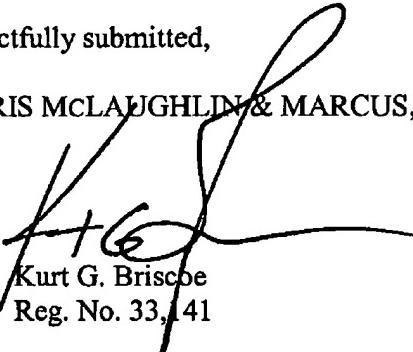
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (914) 332-1700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MC LAUGHLIN & MARCUS, P.A.

By


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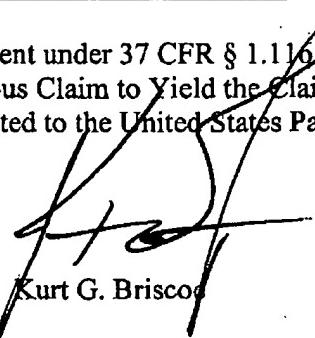
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the attached Mark-Up Showing the Changes Made in the Previous Claim to Yield the Claim as Amended Above (10 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: December 23, 2002

By


Kurt G. Briscoe

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**MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO YIELD
THE CLAIM AS AMENDED ABOVE**

--7. (Once Amended) A method for preventing or reducing the attachment of a lauryl ether sulfate to human skin during a washing process, said method comprising applying said lauryl ether sulfate to the human skin [an effective amount therefor of] in a detergents cosmetic or dermatological preparation comprising the lauryl ether sulfate and more than 3.0% by weight of the preparation of one or more anionic surfactants selected from the group consisting of N-acylamino acids and their salts.--

--13. (Once Amended) A method for desorbing a lauryl ether sulfate from human skin, said method comprising applying to human skin comprising an adsorbed lauryl ether sulfate an [effective] amount [therefor] effective to desorb a content of said adsorbed lauryl ether sulfate from said human skin of a detergents cosmetic or dermatological preparation comprising one or more anionic surfactants selected from the group consisting of N-acylamino acids and their salts.--